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10/731,612	12/09/2003	Jeffrey M. Dils	10710-623(PTG 0633 PUS2)	4771
757 7590 06/15/2007 BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER NGUYEN, PHONG H	
			ART UNIT 3724	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/731,612
Filing Date: December 09, 2003
Appellant(s): DILS ET AL.

**MAILED
JUN 15 2007
GROUP 3700**

Stephen C. Smith
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05/09/2007 appealing from the Office action mailed on November 13, 2006.

Art Unit: 3724

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

D441,771S	BEAN ET AL.	5-2001
5,969,312	SVETLIK ET AL.	10-1999
4,912,848	BIDANSET	4-1990
5,802,943	BRUNSON ET AL.	9-1998
1,119,787	PAUSE	12-1914

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

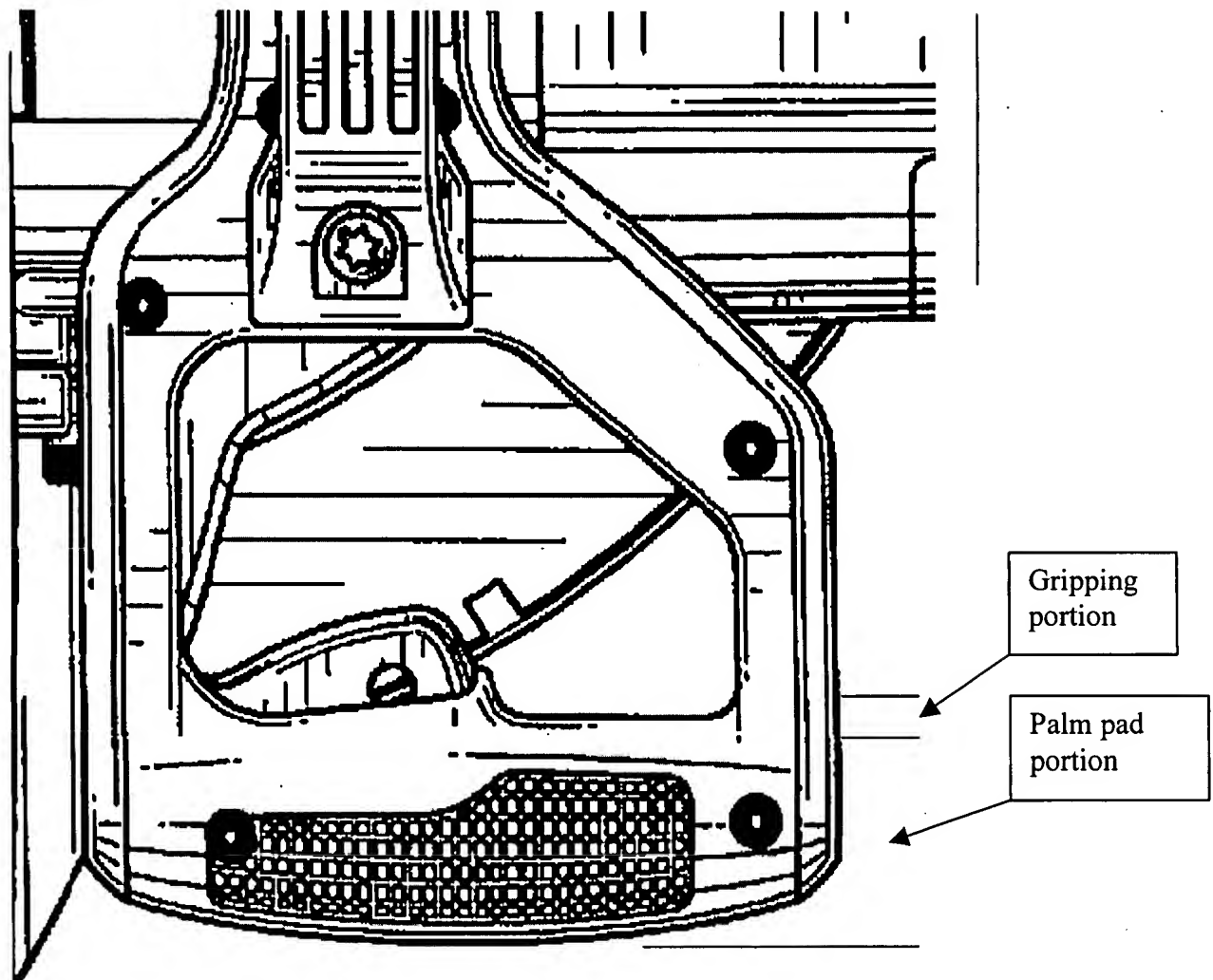
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 4 have been rejected under 35 U.S.C. 102(e) as being anticipated by Bean et al. (D441,771 S), hereinafter Bean.

Bean teaches a miter saw comprising a base, an arm assembly having a handle.

The handle comprises a gripping portion and a palm pad portion. See Figs. 1-7.



The following paragraphs are the Examiner's interpretations of Bean's handle:

The distant (a1) in Fig. 6 is 120 mm. The distant (a2) of a real miter saw is about 559mm, which is 22 inches. Therefore, the scale of Fig. 6 with respect to the real miter saw is $a1/a2 = 120/559 = 1/5$.

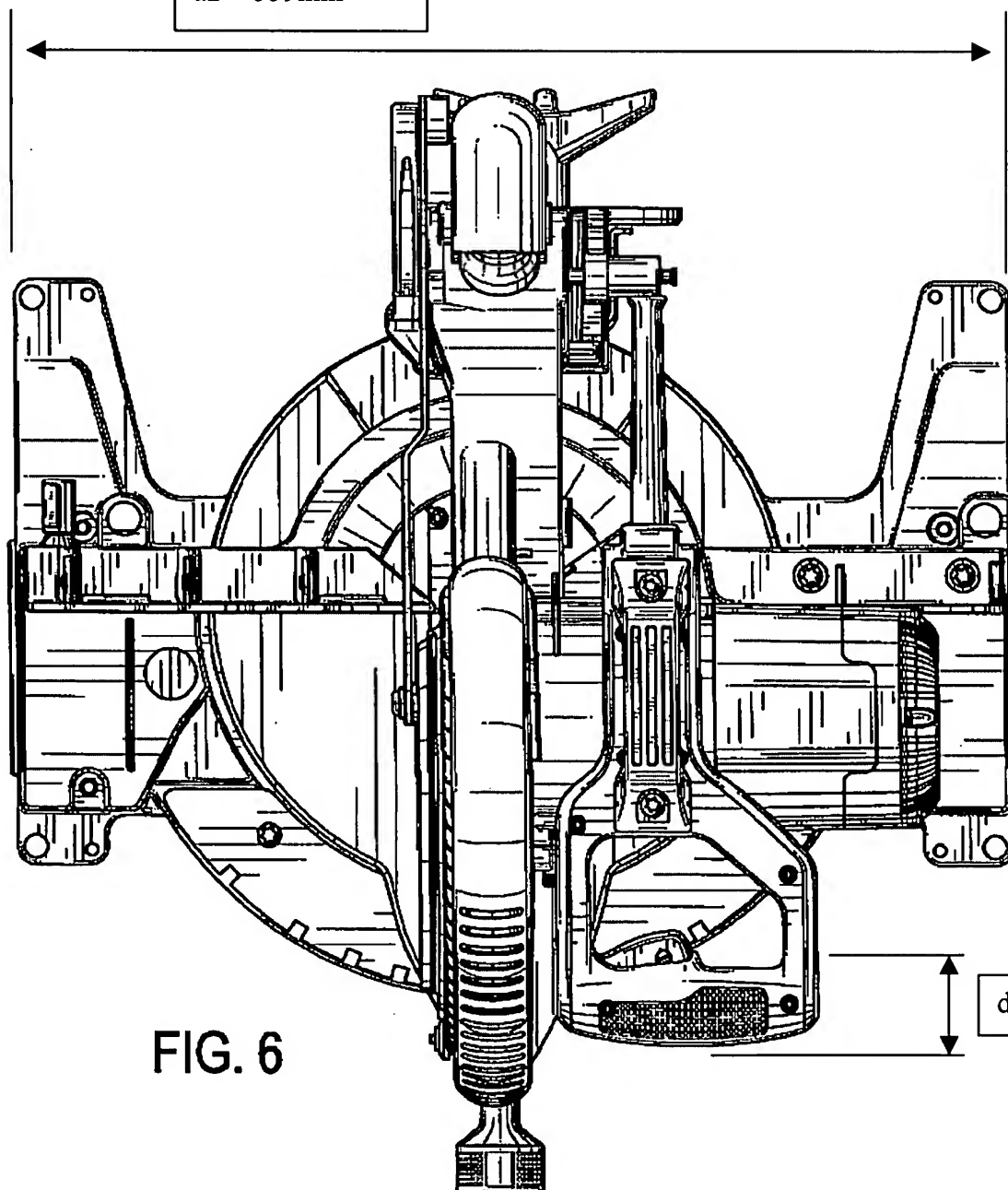
Having the width of the handle being $d1 = 10$ mm and the scale being $1/5$, the distant (d2) of a real miter is $10 \text{ mm} \times 5 = 50 \text{ mm}$, which is 2 inches.

The length of a palm of an adult person is 3-4 inches. The heel portion as defined in Fig. 3 of the Applicant's disclosure is $\frac{3}{4}$ the length of the palm measured from the base of the fingers to the wrist. Therefore, the heel portion has a length about 3 inches. Since the Bean's handle extends into the palm's area defined as the heel portion, Bean meets the limitation (c).

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$a1 = 120\text{mm}$

$a2 = 559\text{mm}$



Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Bean in view of Svetlik et al. (5,969,312), hereinafter Svetlik.

Bean teaches the invention substantially as claimed except for a lock-out switch. Svetlik teaches a lock-out switch. See Fig. 2. Therefore, it would have been obvious to one skilled in the art to incorporate the lock-out switch as taught by Svetlik to the miter saw of Bean for safely operating the miter saw.

5. Claim 3 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Bean in view of Bidanset (4,912,848).

Bean teaches the invention substantially as claimed except for an elastomeric cover. Bidanset teaches providing an elastomeric cover 29 on the handle of a powered saw. See Fig. 3. Therefore, it would have been obvious to one skilled in the art to provide an elastomeric cover as taught by Bidanset on the handle of Bean for damping the vibration of the handle during a cutting operation.

6. Claims 1 and 4-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Brunson et al. (5,802,943), hereinafter Brunson, in view of Bean and Pause (1,119,787).

Regarding claims 1, 4-6 and 9, Brunson teaches a miter saw comprising a base and an arm assembly having a fixed end attached to the base and a free distal end forming a handle 24. See Figs. 3 and 4.

Brunson fails to teach the size of a palm pad portion of the handle and the handle being connected to a central region of the arm assembly via a rotatable joint.

Bean teaches a specific size of the palm pad portion as presented in paragraph 2. Therefore, it would have been obvious to one skilled in the art to incorporate the dimension of the palm pad portion in Bean into the handle of Brunson so that users can comfortably operate the saw.

Pause teaches connecting a handle 12 to a central region via a rotatable joint (15, 16, 17, 18 and 20). See Figs. 1 and 2. Therefore, it would have been obvious to one skilled in the art to incorporate the rotatable joint as taught by Pause to the miter saw of Brunson to increase the adjustability of the handle in the Brunson's saw.

As the rotatable joint is incorporated into the Brunson's saw, the handle in Brunson's saw can be adjustable between at least 0-30 degrees.

Regarding claims 7 and 8, to the degree the Applicant would argue that Bean does not teach a specific dimension of the handle, providing a specific dimension for the handle so that the saw can be marketed to a desired market such as Europe or Asia is routine skill in the art. For example, miter saws for sale in Europe should have bigger handles than ones for sale in Asia since Europeans tend to have bigger hands than Asians do. Therefore, it would have been obvious to one skilled in the art to make a handle

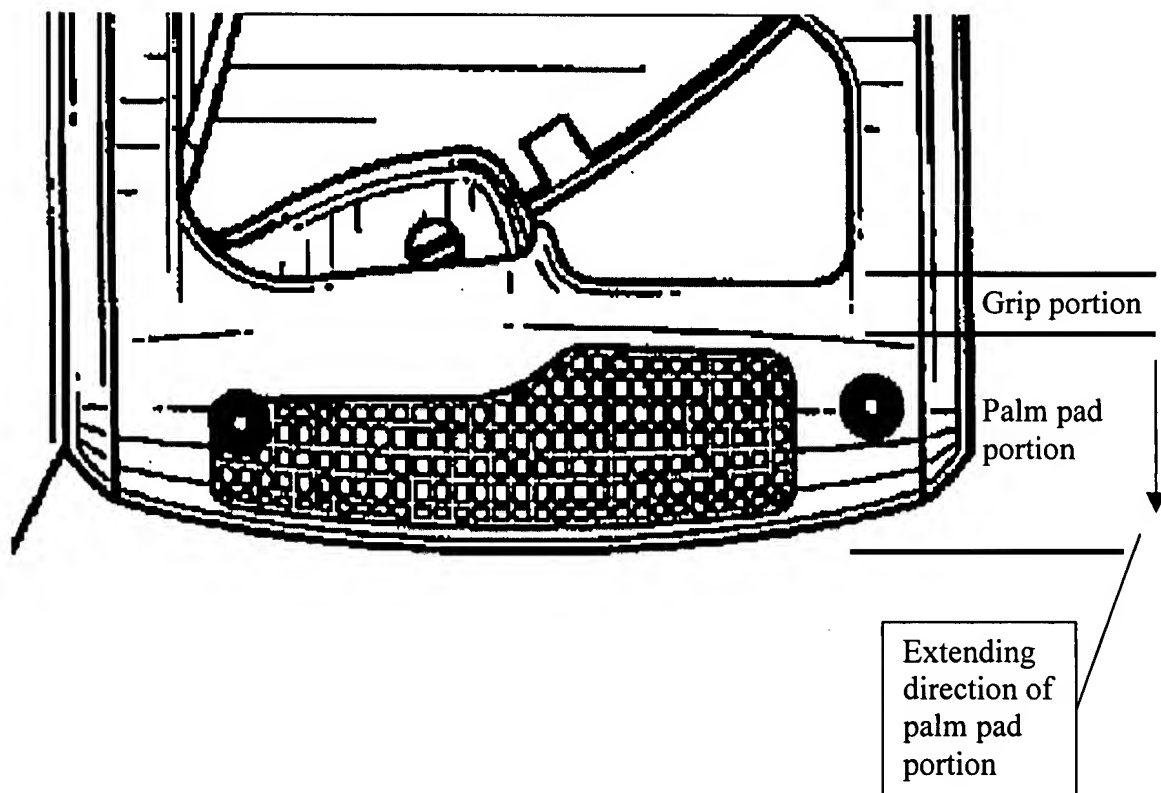
having a width of 3"-4.5" and a thickness of 1.5"-2.5" since such practice is routine skill in the art.

(10) Response to Argument

A. Claims 1 and 4

Applicant's arguments with respect to the Examiner's comments on the dimensions derived from Bean's handle are not persuasive. The Examiner provides additional interpretations on Bean's handle which could be used to apply to claims 7 and 8 which claims the dimensions of the handle. The Examiner's comments on the dimensions in paragraph 2 are superfluous and unnecessary to meet the claim limitations of claims 1 and 4 since claims 1 and 4 do not claim the dimensions of the handle. Therefore, Bean anticipates claims 1 and 4 without the Examiner's comments on the dimensions.

The Applicant argues that Bean does not teach a grip portion sized for a user's fingers to wrap thereabout and a palm pad portion extending outwardly from the grip portion. This argument is not persuasive. A user can wrap his/her fingers about the grip portion. Therefore, the grip portion is sized for a user to wrap thereabout. The palm pad portion clearly extends from the grip portion as shown below. Therefore, Bean clearly anticipated claims 1 and 4.



B. Claim 2

The Applicant argues that Bean does not teach all the claimed limitations and Svetlik does not teach a palm pad portion. This argument is not persuasive. Svetlik is applied to teach the use of a lock-out switch but not the palm pad portion. Bean teaches all other claimed limitations as explained in part A above. Therefore, the combination of Bean and Svetlik clearly teaches all the claimed limitations.

C. Claim 3

The Applicant argues that Bean does not teach all the claimed limitations and Bidanset does not teach a palm pad portion. This argument is not persuasive. Bidanset is applied to teach the use of an elastomeric cover but not the palm pad portion. Bean teaches all other claimed limitations as explained in part A above. Therefore, the combination of Bean and Bidanset clearly teaches all the claimed limitations.

D. Claims 1 and 4-9

The Applicant argues that Brunson does not provide any motivation to allow the orientation of the handle to be modified. This argument is not persuasive. Brunson is a primary reference. A motivation for a 35 USC 103 rejection is from a secondary reference or the level of knowledge of those of skill in the art but not from a primary reference.


The Applicant argues that the Examiner does provide a motivation for combining Brunson and Pause. This argument is not persuasive. The motivation for combining Brunson and Pause is clearly provided in the rejection. Additional motivations as suggested by the Applicant are unnecessary.

For the above reasons, it is believed that the rejections should be sustained.

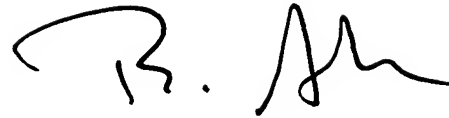
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,


Phong Nguyen: 

June 4, 2007



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